

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent Application of:
Heiko Urtel et al.

Application No.: 10/588,948

Confirmation No.: 2462

Filed: August 10, 2006

Art Unit: 1793

For: HYDROGENATION METHOD FOR
PRODUCING OPTICALLY ACTIVE
ALCOHOLS OR CARBOXYLIC ACIDS
.....

Examiner: C. B. Nguyen

REPLY BRIEF

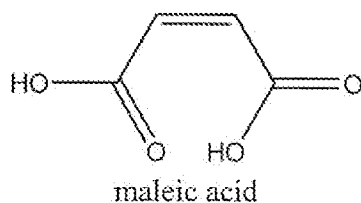
MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a Reply Brief to the Examiner's Answer dated February 18, 2010 under 37 CFR 41.41.

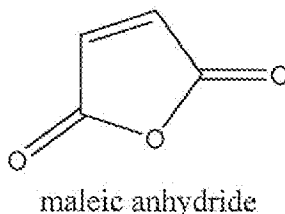
ARGUMENT

The Examiner's Answer, at page 5, line 9, renews the assertion that US Patent No. 4,985,572 to Kitson et al. suggests, at col. 6, line 38, chemical compounds having a stereo-center in the α or β position. Applicants note that the chemical compounds suggested in Kitson at col. 6, line 38, are malaic [sic] acid and maleic anhydride. Applicants are not familiar with a chemical compound named malaic acid. However, Applicants presume that Kitson misspells the name of the chemical compound maleic acid, which has the following structure:

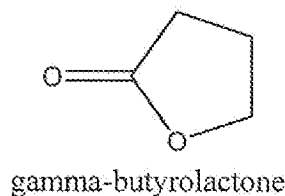


Applicants presumption is based on the fact that Kitson suggests, at col. 6, line 37, maleic acid and malaic [sic] anhydride. Applicants are not familiar with a chemical compound malaic anhydride.

Maleic anhydride, however, has the following structure:



Further, Kitson suggests that malaic [sic] acid or maleic anhydride is reacted to gamma-butyrolactone, suggesting that maleic acid was meant because maleic acid and maleic anhydride may be hydrogenated to form gamma-butyrolacton, which has the following structure:



The Appeal Brief and the October 2, 2009 Response to Office Action noted for the Examiner that neither maleic acid nor maleic anhydride are optically active compounds because they do not contain a stereocenter. Nevertheless, instead of pointing out why Applicants' argument that neither maleic acid nor maleic anhydride are optically active compounds is not

considered persuasive, the Examiner merely reasserts that these compounds have a stereocenter. Applicants respectfully request that the Examiner demonstrates where the stereocenter of maleic acid or maleic anhydride is considered to be or that the argument be withdrawn.

At page 8, lines 5-7, the Examiner's Answer asserts that "Kitson (572) teaches an improved hydrogenation process of carboxylic acids to make the corresponding alcohols to minimize racemix [sic] and unwanted by-products." Applicants are not familiar with the term "racemix" and a text search of Kitson did not retrieve this term in the patent. Should it be the Examiner's contention that Kitson suggests minimizing the formation of a racemic mixture? If this is indeed the Examiner's contention, Applicants respectfully request that the Examiner provides support for the assertion that Kitson suggests minimizing the formation of a racemic mixture. Applicants note that it would be difficult to reconcile such an assertion with the Examiner's argument at page 8, lines 12-14 that "Kitson is silent and does not discuss 'optically active' carboxylic acids as starting materials nor the optically active final products, ie alcohols and carboxylic acids."

At page 9, paragraph C., the Examiner's Answer states that the unexpected results were not presented in the form of a Declaration or Affidavit. As Applicants noted at page 8, first full paragraph, of the January 15, 2009 Response, Applicants will provide the data in the form of a verified statement upon request by the Examiner. No request has been made prior to the Examiner's Answer. Thus, Applicants maintain that the April 2, 2009 Office Action did not answer all asserted advantages.

Applicants thank the Examiner for noting a typographical error at page 10, third line from the bottom of the Appeal Brief. Instead of Pr/Sn, the Appeal Brief should have referred to Pt/Sn, as correctly set forth at page 11, line 5 and the following table of the Appeal Brief.

The Examiner's Answer states that the Terminal Disclaimer filed January 15, 2010 has not been approved because it is not signed by an attorney of record. Applicants concurrently herewith submit a new Power of Attorney appointing all practitioners associated with customer number 30678 as attorneys or agents. Further, Applicants concurrently herewith submit a

Terminal Disclaimer signed by a practitioner associated with customer number 30678. Accordingly, the rejection of claims 1, 2, 8, 10, 12-14, and 18 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 6, 9, and 12-17 of U.S. Patent No. 7,507,866 to Urtel et al. has been overcome by the concurrent filing of a Terminal Disclaimer. The filing of the Terminal Disclaimer is not to be construed as an admission, estoppel or acquiescence. See *Quad Environmental Technology v. Union Sanitary District*, 20 USPQ2d 1392 (Fed. Cir. 1991) and *Ortho Pharmaceuticals Corp. v. Smith*, 22 USPQ2d 1119 (Fed. Cir. 1992).

CONCLUSION

In view of the above comments and our Appeal Brief, it is abundantly clear that the Examiner has erred in the rejection of claims 1-5 and 7-21. Accordingly, it is respectfully requested that the Board reverse the Examiner and allow pending claims 1-5 and 7-21.

Applicants herewith submit a believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 12810-00340-US1 from which the undersigned is authorized to draw.

Dated: April 16, 2010

Respectfully submitted,

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